



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,414	02/01/2002	Noriyoshi Hiraoka	FS.F4138US2RAC	4645

20995 7590 11/20/2002

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

BASINGER, SHERMAN D

ART UNIT	PAPER NUMBER
----------	--------------

3617

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,414

Applicant(s)

HIRAOKA ET AL.

Examiner

Sherman D. Basinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/857,016.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Reissue Applications

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Applicant in the reissue declaration stated:

New claims are being added that broaden the claimed subject matter. For instance, the new claims presented in the reissue application broaden the recitation that the "first and second banks [are] arranged generally in a 'V' shape".

This is insufficient in that the reissue declaration while identifying a single word, phrase, or expression in the original claims (first and second banks [are] arranged generally in a 'V' shape) that rendered the original patent wholly or partly inoperative or invalid did not state how this word, phrase or expression rendered the original patent wholly or partly inoperative or invalid. The reissue declaration merely stated that new "claims are being added that broaden the claimed subject matter". Further, the reissue declaration did not identify any error in the claims by reference to the specific claim(s) and the specific claim language wherein lies the error.

2. Claims 1-20 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the reissue declaration is set forth in the discussion above in this Office action.

3. Although the reissue declaration filed in the instant application has not been found to comply with 37 C.F.R. 1.175(a), once the reissue declaration is found to comply with 37 C.F.R. 1.175(a), if during the prosecution of the reissue application, amendments are made and additional errors in the patent are corrected, a supplemental declaration is needed before the application can be allowed.

An example of acceptable language to be used in a supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

4. An offer to surrender the original patent has been received; however, the original patent was not surrendered. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

5. Applicant failed to include in the reissue claims the changes, additions and deletions made by the Certificate of Corrections dated the twenty-first day of August, 2001. These changes to the original patent grant should have been made in the reissue application without underlining or bracketing. See MPEP 1411.01.

6. Further, in accordance with 37 C.F.R. 1.173(a)(1) a copy of the Certificate of Corrections dated twenty-first day of August, 2001 should have been included.

7. In accordance with 37 C.F.R. 1.173(b), new claims 13-20 should have been underlined. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

8. Claims 13-20 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

In claim 13 the "cylinder block including a cylinder block exhaust passage" is new matter. The specification as originally filed in patent 5,893,783 does not provide support for the "cylinder block exhaust passage" now defined in new claim 13.

In claim 16 "the exhaust runner" and the "pair of connecting exhaust conduits" of lines 7-11 have no support in the specification as originally filed in patent 5,893,783 and are new matter.

In claim 17, lines 10-12 "an exhaust passage being formed in said cylinder block and comprising a first branch, a second branch and a convergent portion that combines said first branch and said second branch" has no support in the specification as originally filed in patent 5,893,783 and is new matter.

In claim 18 "a first connection passage and a second connection passage respectively" has no support in the specification as originally filed in patent 5,893,783 and is new matter.

In claim 19 defining the first and second connection passages as being formed within the first cylinder head assembly and the second cylinder head assembly respectively has no support in the specification as originally filed in patent 5,893,783 and is new matter.

Art Unit: 3617

9. Claims 13-20 are rejected under 35 U.S.C. 251 as not being for the same invention as that disclosed in the original patent.

Claims presented in the reissue application are considered to satisfy the requirement of 35 U.S.C. 251 that the claims be "for the invention disclosed in the original patent" if the claims presented in the reissue application are described in the original patent specification and are enabled in the original patent specification. The inventions claimed in new claims 13-20 are neither described in the original patent specification of patent 5,893,783 nor are they enabled by the specification as originally filed in patent 5,893,783.

The specification as originally filed in patent 5,893,783 fails to describe in detail such that it is enabled the cylinder block exhaust passage of claim 13, the exhaust runner being in selective communication with the exhaust port of the cylinder head and being formed between the exhaust port of the cylinder head and the exhaust manifold of claim 16, the pair of connecting exhaust conduits of claim 16, the exhaust passage being formed in the cylinder block and comprising first and second branches and a convergent portion that combines the branches of claim 17, the first connection passage and the second connection passage of claim 18 and the first and second connection passages which are formed within the first cylinder head assembly and the second cylinder head assembly, respectively, of claim 19.

Priority

10. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 08/857016 under 35 U.S.C. 119(a)-(d) or (f), applicant must identify the application containing the priority papers.

11. An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). Applicant should make reference to serial number 09/835917 filed April 13, 2001, of which the instant application is a continuation and which is now abandoned, in the first sentence of the specification of the instant application. In amending the specification, applicant should comply with 37 C.F.R. 1.173.

Drawings

12. The drawings are objected to because in figure 3 reference numeral 139 pointing out the coolant pool should be changed to 140; in figure 8 one of the surge tanks is incorrectly pointed out by reference numeral 71 (it should be 76); and in figure 20, the embodiment wherein the starter motor is between the cylinder banks, a second starter motor 146d is shown between the crankcase and the branch 78d (the second starter motor should be deleted). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The

Art Unit: 3617

objection to the drawings will not be held in abeyance. Applicant in amending the drawings should comply with 37 C.F.R. 1.173(b)(3).

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 13-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as originally filed fails to describe in detail such that it can be made and used the cylinder block exhaust passage of claim 13, the exhaust runner being in selective communication with the exhaust port of the cylinder head and being formed between the exhaust port of the cylinder head and the exhaust manifold of claim 16, the pair of connecting exhaust conduits of claim 16, the exhaust passage being formed in the cylinder block and comprising first and second branches and a convergent portion that combines the branches of claim 17, the first connection passage and the second connection passage of claim 18 and the first and second connection passages which are formed within the first cylinder head assembly and the second cylinder head assembly, respectively, of claim 19.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziegler. In Ziegler the cylinder head exhaust passage is 61, the exhaust guide passage is 67, the cylinder block exhaust passage is 75, and the manifold is 103.

17. Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakai et al. In Nakai et al the cylinder head exhaust passage is 86, the exhaust guide passage is either of passages 92, the cylinder block exhaust passage is the lower end of manifolds 88, and the manifolds are 88. The engine of Nakai et al has a v-type configuration.

18. Claims 16-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Isogawa.

In Isogawa the exhaust guide passage are each of 47, the crankcase, the crankshaft, the cylinders, the cylinder block, the cylinder heads and the cylinder banks are shown in figure 2, the exhaust runners are 44, the exhaust ports are the openings in the cylinders which communicate with the runners 44, the two exhaust manifolds are at the outlet ends of runners 44, the pair of connecting exhaust conduits are 46, and the pair of passages formed in the cylinder block and that are in registry with the connecting exhaust conduits are the common collector sections 45. Passages 45 merge within the

cylinder block into an exhaust discharge as is shown in figure 3. This discharge is coupled to the exhaust guide passage 47 through connecting exhaust conduits 46. For claim 17, the first branch and the second branch are collector sections 45. The convergent portion and the first connection passage and the second connection passage are at the upper ends of sections 45.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references were cited in patent 5,893,783: Irgens, Sakurai et al, Okumura et al, Torigai, Gubon et al, Fujimoto, Takahashi et al 866 and Takahashi et al 023. Duret et al is cited to show the embodiments of figures 8 and 9.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Art Unit: 3617

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Sherman D. Basinger
Primary Examiner
Art Unit 3617

4
12
02

sdb
November 12, 2002